

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Michael D. Ellis

Confirmation No.: 7521

Application No.: 09/974,666

Art Unit: 2623

Filed: October 9, 2001

Examiner: Shang, Annan Q.

For: **SYSTEMS AND METHODS FOR CACHING
DATA IN MEDIA-ON-DEMAND SYSTEMS**

PRE-APPEAL BRIEF REASONS FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

In response to the final Office Action pending in the above referenced application, applicant requests a panel review of the pending rejections prior to proceeding with the full appeals process. Applicant encloses the requisite Notice of Appeal along with the remarks set forth below.

The application includes 79 claims (claims 1-16, 18-36, 38-56, 58-75, and 77-83), four of which (claims 1, 21, 41, and 61) are independent. Claims 17, 37, 57, and 76 have been cancelled. Claims 1, 2, 4, 5, 7, 18-22, 24, 25, 27, 38-42, 44, 45, 47, 58-62, 64, 65, 67, and 78-83 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Shah-Nazaroff U.S. Patent No. 6,157,377 ("Shah-Nazaroff"). Claims 3, 23, 43, and 63 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Shah-Nazaroff in view of Hoffman U.S. Patent No. 5,883,677 ("Hoffman"). Claims 6, 26, 46, and 66 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Shah-Nazaroff in view of Matthews III U.S. Patent No. 5,815,145 ("Matthews"). Claims 8, 9, 13, 28, 29, 33, 48, 49, 53, 68, 69, and 73 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Shah-Nazaroff in view of Banker U.S. Patent No. 5,485,221 ("Banker"). Claims 10, 30, 50, and 70 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Shah-Nazaroff in view of Lett U.S. Patent No. 5,771,064 ("Lett"). Claims 11, 12, 31, 32, 51, 52, 71, and 72 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Shah-Nazaroff in view of Lewis U.S.

Patent Application Publication No. 2003/0040962 ("Lewis"). Claims 14, 15, 34, 35, 54, 55, 74, and 75 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Shah-Nazaroff in view of Aristides U.S. Patent No. 5,630,119 ("Aristides"). Claims 16, 36, and 56 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Shah-Nazaroff in view of Rosin U.S. Patent No. 6,028,600 ("Rosin"). Claim 77 has been rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Shah-Nazaroff in view of Hooper U.S. Patent No. 5,414,455 ("Hooper"). Applicants respectfully disagree and assert that the above rejections are based on clear error.

For the purposes of this Request, Applicants specify the clear errors in the rejection of independent claims 1, 21, 41, and 61 in the October 1, 2008 final Office Action (hereinafter "Office Action"). Applicants reserve the right to present additional arguments subsequent to the decision of the panel review.

I. Shah-Nazaroff does not disclose automatically establishing a client-server connection between the interactive television application system and the on-demand media data source

Shah-Nazaroff merely discloses a programming database that is updated on a regular basis through downloads from any of a number of sources, such as by receiving updated programming information from broadcast sources over the Internet (Shah-Nazaroff, col. 4, lines 1-8). While the Examiner refers to various instances where a client-server relationship may be established (*see* Office Action, page 3), none of the instances disclose "automatically establishing a client-server connection." In fact, the Examiner contradicts himself by admitting that "[u]pon a user interaction to request for service(s) SS-140 or PS-310 automatically uses the user interface (fig. 2.210) and coordinates the launching of the particular service requested" (Office Action, page 3). The Examiner's assertion that a "user interaction" is required to initiate an automatic process indicates a misunderstanding of "automatically establishing a client-server connection" as recited in independent claims 1, 21, 41, and 61. One advantage of the recited claims is that on-demand media data is retrieved automatically from the on-demand media data source and cached locally so that a user does not experience a delay in accessing the on-demand media data (*e.g.*, by having to retrieve it from the remote on-demand media data source) when the user requests the on-demand information.

While Shah-Nazaroff states that programming information can be obtained from the Internet, Shah-Nazaroff does not explicitly or implicitly disclose that the programming information is retrieved through a client-server connection because there is no disclosure of a request being made. In fact, since Shah-Nazaroff does not disclose that the programming information is requested from the broadcast sources, only that it is "downloaded" or "received" (Shah-Nazaroff, col. 4, lines 1-7), one of ordinary skill likely recognizes that the programming information in Shah-Nazaroff is received through a regular broadcast from the broadcast sources.

Thus, Shah-Nazaroff does not disclose "automatically establishing a client-server connection between the interactive television application system and the on-demand media data source " as recited in independent claims 1, 21, 41, and 61. Because Shah-Nazaroff does not teach all of the elements of independent claims 1, 21, 41, and 61, the § 102 Rejection is based on clear error of fact and, therefore, should be withdrawn.

II. Shah-Nazaroff does not disclose automatically retrieving the on-demand media data from an on-demand media source

In the Office Action, the Examiner asserts that the Shah-Nazaroff system "automatically retriev[es] the on-demand media data from the on-demand media data source" and specifically cites to col. 4, lines 1-7 of Shah-Nazaroff to support this assertion (Office Action, page 2). However, the cited portion of Shah-Nazaroff (col. 4, lines 1-7) clearly refers to a program database 220 directed only to non-on-demand media data from a broadcast source. More particularly, Shah-Nazaroff states:

Programming database 220 can be updated on a regular basis. For instance new programming information can be downloaded daily or weekly from any of a number of sources and stored in programming database 220. In one embodiment, client system 110 automatically receives updated programming information from broadcast sources 130 over the Internet on a daily bases.

Shah-Nazaroff, col. 4, lines 1-7. Shah-Nazaroff further states that "[f]rom program database 220, user interface 210 can retrieve optional upgrades available for each broadcast. In one embodiment, programming database 220 also includes a programming guide which lists broadcasts by time and channel" (Shah-Nazaroff, col. 3, lines 59-67, emphasis added). In contrast, on-demand media does not have associated broadcast times because it is made available in response to a user demand at any time.

According to the CAFC, "[a]n interpretation of prior art references requires a 'fair reading of these references as a whole.'" (See *In Re Pieter Kramer*, 18 U.S.P.Q.2D (BNA) 1415). A fair reading of col. 4, lines 1-7 of Shah-Nazaroff clearly indicates that Shah-Nazaroff's programming guide merely refers to non-on-demand media data because it explicitly states that the programming guide lists broadcasts by time and channel. While Fig. 5 of Shah-Nazaroff may show on-demand information, Shah-Nazaroff provides no teaching of how the on-demand information is retrieved. Shah-Nazaroff clearly does not teach or suggest that the on-demand media data shown in Fig. 5 is automatically retrieved from an on-demand media data source.

Thus, Shah-Nazaroff does not disclose "automatically retrieving the on-demand media data from the on-demand media data source" as recited in independent claims 1, 21, 41, and 61. Because Shah-Nazaroff does not teach all of the elements of independent claims 1, 21, 41, and 61, the § 102 Rejection is based on clear error of fact and, therefore, should be withdrawn.

Because claims 2, 4, 5, 7, 18-20, 22, 24, 25, 27, 38-40, 43, 44, 45, 47, 58-60, 62, 64, 65, 67 and 78-83 depend from, and are limited by, independent claims 1, 21, 41, and 61, the § 102 Rejection for these claims is also based on clear error of fact and, therefore, should be withdrawn.

III. The Rejections under 35 U.S.C. § 103

Because none of the other cited references make up for the above-discussed deficiencies of Shah-Nazaroff, the various § 103 Rejections of the pending claims should also be withdrawn.

IV. Conclusion

For at least the foregoing reasons, applicants respectfully submit that this application is in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Dated: April 1, 2009

Respectfully submitted,

/Christopher P. Carroll/

Christopher P. Carroll
Registration No. 55,776
Attorney for Applicants
ROPES & GRAY LLP
Customer No. 75563